

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-32, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Claims 1-9, 11-19, 21-29, 31 and 32 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,875,185, issued to Wang et al. (hereinafter, Wang). Claims 10, 20 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang, in view of U.S. Patent No. 7,200,673, issued to Augart (hereinafter, Augart). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

#### **I. Examiner's Response to Arguments**

The Examiner states the following in the Final Office Action:

At page 20, with respect to claim 1, applicant argues that Wang fails to disclose, "identifying a location of a network device within the hybrid wired/wireless network, the network device being movable within the hybrid wired/wireless network." In reply, the claim limitations of "identifying a location of a movable network device within the hybrid wired/wireless network, the network" read on "moving of MTa using location message between old BS and new BS as described in 104 fig.9A and shown in fig 4. Therefore, the examiner respectively disagrees.

See the Final Office Action at page 6. The Applicant respectfully disagrees with the above argument. Referring to FIGs. 4 and 6 of Wang, the Applicant points out that **the only network device that is “movable” within the network is the mobile terminal (MT) or cell (C) 64**. The base stations (BS) 60a, 60b, as well as the switches 54, 58 that are used during handoff, are all stationary. The Applicant fails to see how “moving of MTa using location message between old BS and new BS” reads on “identifying a location of a network device,” as recited in Applicant’s claim 1. As already stated in the July 30, 2007 response, in step 104 of FIG. 9A, **Wang discloses that a “location message” is issued to the original base station BS<sub>ORIG</sub>. However, this “location message” contains the location of the new base station BS<sub>NEW</sub>, and it does not contain the location of the mobile terminal (MT<sub>a</sub>)**. Therefore, since Wang does not identify a location for any of the mobile terminals, the Applicant maintains that Wang does not disclose or suggest at least the limitation of “identifying a location of a network device within the hybrid wired/wireless network, the network device being movable within the hybrid wired/wireless network,” as recited by the Applicant in independent claim 1.

## **REJECTION UNDER 35 U.S.C. § 102**

### **II. Wang Does Not Anticipate Claims 1-9, 11-19, 21-29, and 31-32**

The Applicant first turns to the rejection of claims 1-9, 11-19, 21-29, and 31-32 under 35 U.S.C. 102(b) as being anticipated by Wang. With regard to the anticipation rejections under 102(b), MPEP 2131 states that “[a] claim is anticipated only if **each and every element** as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See Manual of Patent Examining Procedure (MPEP) at 2131 (internal citation omitted). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See *id.* (internal citation omitted).

**A. Rejection of Independent Claim 1 under 35 U.S.C. § 102 (b)**

With regard to the rejection of independent claim 1 under 35 U.S.C. § 102(b), the Applicant submits that Wang does not disclose or suggest at least the limitation of “identifying a location of a network device within the hybrid wired/wireless network, the network device being movable within the hybrid wired/wireless network,” as recited by the Applicant in independent claim 1.

The Final Office Action states the following with regard to claim 1:

Regarding claims 1 and 21, Wang discloses a method [and a system] for providing location based configuration in a hybrid wired/wireless network, the method comprising: - identifying a location (using location message, see 104-108 fig.9A) of a network device (one of MT, BS, & Switch, see fig.4) within the hybrid wired/wireless network (as shown in fig.4);

See the Final Office Action at page 2. The Final Office Action relies for support on steps 104-108 in Figure 9a of Wang. Wang discloses the following with regard to Figure 9a:

FIGS. 9a and 9b are a flow chart of a preferred handoff method 100 according to the inventive method. The preferred method begins when mobile terminal MTa moves from a previous coverage area  $C_i$  covered by  $BS_{\text{ORIG}}$  to a new coverage area  $C_1$  covered by  $BS_{\text{NEW}}$  (step 102). When this happens MTa issues two messages. **It issues to  $BS_{\text{ORIG}}$  a "location message" containing the location of  $BS_{\text{NEW}}$ . It issues to  $BS_{\text{NEW}}$  a "connection message" containing  $VCC_{k,a}$ , where  $k=1,2, \dots n$  (step 104).** When  $BS_{\text{ORIG}}$  receives the "location message", it issues to the switch to which it is connected, via of the handoff VC, a "routing message" containing  $VCC_{k,a}$ , the location of  $BS_{\text{ORIG}}$ , and the location of  $BS_{\text{NEW}}$  (step 106). The switch to which  $BS_{\text{ORIG}}$  is connected compares the location of  $BS_{\text{ORIG}}$  and the location of  $BS_{\text{NEW}}$  and determines if MTa's mobility is intra- or inter-switch (step 108).

See Wang, col. 8, lines 30-45 (emphasis added). Initially, the Applicant points out that Figure 9a of Wang describes a "seamless handoff method" and it is not related to providing location based configuration in a hybrid wired/wireless network. More specifically, Wang uses virtual channel connections (VCCs), which are identified by VCC characteristics, to achieve the seamless handoff.

The Applicant points out that the "location message" of Wang is for purposes of identifying the location of a base station  $BS_{\text{NEW}}$  (the Final Office Action is apparently equating the "network device" limitation of Applicant's claim 1 with the base station  $BS_{\text{NEW}}$ ). **Since a base station, such as  $BS_{\text{NEW}}$ , as well as its**

**corresponding switch, such as switch 54, are all stationary and are not movable within the wireless network, the “location message” disclosed by Wang in Figure 9a does not identify a location of a network device within a hybrid wired/wireless network, where the network device, identified by the Final Office Action as BS<sub>NEW</sub>, is movable within the hybrid wired/wireless network.** Since the only movable network device is the mobile terminal MT, the Applicant points out that Wang is silent as to identifying a location of the mobile terminal MT.

Therefore, the Applicant maintains that Wang does not disclose or suggest at least the limitation of “identifying a location of a network device within the hybrid wired/wireless network, the network device being movable within the hybrid wired/wireless network,” as recited by the Applicant in independent claim 1.

Furthermore with regard to the rejection of independent claim 1 under 35 U.S.C. § 102(b), the Applicant submits that Wang does not disclose or suggest at least the limitation of “determining configuration information corresponding to said determined location of said network device,” as recited by the Applicant in independent claim 1.

The Final Office Action states the following with regard to claim 1:

Regarding claims 1 and 21, Wang discloses a method [and a system] for providing location based configuration in a hybrid wired/wireless network, the method comprising:

\* \* \*

- determining configuration information (connecting message, see 104 fig.9A) corresponding to the determined location of the network device (MTa moves from old BS to new BS, see 104 fig.9A);

See the Final Office Action at page 2. The Examiner is equating Applicant's "configuration information" with Wang's "connecting message." The Applicant points out that, as stated in step 104 of Wang's FIG. 9a, the "connecting message" consists of virtual channel connection (VCC) information. Furthermore, in instances of intra-switch signal processing (e.g., FIG. 4 of Wang), the virtual channel is used between a base station and a switch. See Wang, col. 6, lines 7-9. In instances of inter-switch signal processing (e.g., FIG. 6 of Wang), the virtual channel is used only between the base stations. See Wang, col. 7, lines 18-19. In this regard, **in both signal processing scenarios disclosed by Wang, the VCC corresponds only to a base station and/or a switch and it does not correspond to any of the MTs.** Therefore, the Applicant maintains that Wang does not disclose or suggest at least the limitation of "determining configuration information corresponding to said determined location of said network device," as recited by the Applicant in independent claim 1.

Furthermore with regard to the rejection of independent claim 1 under 35 U.S.C. § 102(b), the Applicant submits that Wang does not disclose or suggest at least the limitation of "communicating said determined configuration information to

said networking device for providing location based configuration of said network device,” as recited by the Applicant in independent claim 1.

The Final Office Action states the following with regard to claim 1:

Regarding claims 1 and 21, Wang discloses a method [and a system] for providing location based configuration in a hybrid wired/wireless network, the method comprising:

\* \* \*

- communicating the determined configuration information to the networking device (communication between old BS and Switch, see 106 fig.9A) for providing location based configuration of the network device (106 fig.9A).

See the Final Office Action at pages 2-3. The Final Office Action relies for support on step 106 in Figure 9a of Wang. Step 106 in Figure 9a of Wang discloses that after BS<sub>ORIG</sub> receives the "location message", **it issues to the switch** to which it is connected, a "routing message" containing VCC<sub>k,a</sub>, the location of BS<sub>ORIG</sub>, and the location of BS<sub>NEW</sub>. The Applicant points out that **the “routing message” is issued to the switch, i.e., it is not issued or communicated to the base station BS<sub>NEW</sub>**, which the Final Office Action has equated to Applicant’s “network device.” Furthermore, the Applicant points out that the “routing message” contains information that is used for establishing a handoff between two base stations and it is not used to configure a network device, as recited in Applicant’s claim 1.

Therefore, the Applicant maintains that Wang does not disclose or suggest at least the limitation of “communicating said determined configuration information to said networking device for providing location based configuration of said network device,” as recited by the Applicant in independent claim 1.

Accordingly, independent claim 1 is not anticipated by Wang and is allowable. Independent claims 11 and 21 are similar in many respects to the method disclosed in independent claim 1. Therefore, the Applicant submits that independent claims 11 and 21 are also allowable over the references cited in the Final Office Action at least for the reasons stated above with regard to claim 1.

**B. Rejection of Dependent Claims 2-9, 12-19, 22-29, 31 and 32**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 102(b) as being anticipated by Wang has been overcome and requests that the rejection be withdrawn. Additionally, claims 2-9, 12-19, 22-29, 31 and 32 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 2-9, 12-19, 22-29, 31 and 32.

## REJECTION UNDER 35 U.S.C. § 103

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure ("MPEP") states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

See MPEP at § 2142, citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added). Further, MPEP § 2143.01 states that "the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination," and that "although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a *suggestion or motivation in the reference* to do so'" (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP § 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion..., citing *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999). Additionally, if a *prima facie* case of obviousness is not established, the Applicant is under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See MPEP at § 2142.

### **III. The Proposed Combination of Wang and Augart Does Not Render Claims 10, 20 and 30 Unpatentable**

Based on at least the foregoing, the Applicant believes the rejection of independent claims 1, 11 and 21 under 35 U.S.C. § 102(b) as being anticipated by Wang has been overcome and requests that the rejection be withdrawn. Additionally, since the additional cited reference (Augart) does not overcome the deficiencies of Wang, Claims 10, 20 and 30 depend from independent claims 1, 11 and 21, respectively, and are, consequently, also respectfully submitted to be allowable at least for the reasons stated above with regard to allowability of claim 1. The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 10, 20 and 30.

**CONCLUSION**

Based on at least the foregoing, the Applicant believes that all claims 1-32 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and requests that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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